

REMARKS

After entry of this amendment, claims 1-14 will be pending in this patent application. By this Amendment, claims 1 and 5 have been amended. No new matter has been added. Applicants respectfully request reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 09-050358 to Funakoshi (hereinafter “JP ‘358”) in view of JP 08-129375 to Yamamura, *et al.* (hereinafter “JP ‘375”).¹ Applicants respectfully traverse this rejection for at least the following reasons.

In order for a prior art reference or combination of references to render a claim obvious, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant’s disclosure.

See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Of the claims that are presently pending in this patent application, claims 1 and 5 are independent. Claim 1 recites a real-size display system in which, *inter alia*, “an image converter...receives first image information, converts the first image information into second

¹ It appears that the rejections are based upon computerized translations of the two references that were provided by the online information systems of the Japanese Patent Office. Applicants’ response is also based on

image information and outputs the second information to [a] flat panel display unit.” The first image information “includes measurement information reflective of the actual size of one or more objects described by the first image information.” Claim 5 recites additional features, and Applicants will present additional, separate arguments below, but claim 5 also includes the feature of measurement information “reflective of actual size.” Applicants submit that neither of the two cited references discloses or suggests those features.

As best as Applicants are able to determine, JP ‘358 discloses a “What You See is What You Get” document editing system that has a graphical ruler capable of being placed by the user at an arbitrary angle. According to the English-language abstract of JP ‘358, “the document processor can display a produced document image in an image equivalent to a print image to be printed.” Thus, as best as Applicants are able to determine, JP ‘358 discloses a system which converts between screen and printer so that the “document image” appears to be consistent between the two.

However, whatever JP ‘358 may disclose regarding the conversion of image sizes between print sizes and screen sizes, Applicants submit that image information processed in JP ‘358 does not include measurement information “reflective of the actual size” of an object in an image. Applicants submit that neither the screen size nor the print size of a document object in the JP ‘358 reference is an actual size; rather, both screen size and print size are arbitrary and dependent upon the characteristics of the respective screen and print output devices.

Applicants note that on page 3 of the Office Action, the Examiner admits that JP ‘358 discloses conversion between two arbitrary coordinate systems, which JP ‘358 and the Examiner

these translations, although Applicants reserve the right to withdraw or modify these remarks if a more idiomatic translation becomes available.

denote as (u,v) and (x,y). In paragraph [0021] of JP '358, the reference discloses that the two coordinate systems reflect the print and screen sizes, respectively.

The Examiner cites JP '375 primarily for its disclosure of liquid crystal displays. Applicants respectfully submit that whatever JP '375 may disclose with respect to liquid crystal displays, it does not remedy the "defects" of the JP '358 reference. JP '375 appears to disclose a video sizing method that does not manipulate image information reflective of the actual size of objects in the image.

Therefore, even if JP '358 and JP '375 were to be combined, the combination would not disclose or suggest all of the features recited in claims 1 and 5. Accordingly, Applicants respectfully request that the rejection of those claims be withdrawn.

Applicants respectfully submit that the claims depending from claims 1 and 5 are not rendered obvious by the cited combination of references for at least the same reasons as claims 1 and 5 are not rendered obvious. However, Applicants wish to address some of the Examiner's comments and arguments with respect to the dependent claims.

For example, in rejecting claim 2, the Examiner asserts that "the steps are obvious, because image information should have magnification, horizontal synchronization signal, vertical synchronization signal, clock and measured distance data. Applicant should be more explicit about mentioned information rather than general terms."²

Applicants strongly disagree with the Examiner's position, and respectfully submit that the Examiner appears to have rejected claim 2 without providing any evidence in support of his position. To the extent that the Examiner may be taking Official Notice or reasoning without

² Applicants note that the Examiner uses the term "steps" several times in making the rejection. Applicants respectfully remind the Examiner that neither claim 1 nor claim 2 is a method claim. Therefore, Applicants submit that the term "steps" is improperly used.

evidentiary support to make the rejection, Applicants respectfully request that the Examiner produce a reference to substantiate the assertions made in rejecting claim 2.

Applicants note that both of the cited references are silent as to what image information “should” have. Moreover, Applicants respectfully submit that, in particular, there is no reason why generic image information “should” have measured distance data. In the absence of anything more than the Examiner’s naked assertion to support the rejection, Applicants can draw no other conclusion than that the Examiner has employed impermissible hindsight in using Applicants’ own specification to reject the claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Moreover, with respect to the Examiner’s suggestion that Applicants should be “more explicit” in the language of claim 2, Applicants respectfully remind the Examiner that a patent applicant is entitled to claim his or her invention broadly. The relevant inquiry is not whether the claim language is broad *per se* but whether that broad claim language is anticipated or rendered obvious by the prior art. In this case, for at least the reasons set forth above, Applicants submit that claim 2 is not anticipated or rendered obvious by the cited prior art; therefore, its breadth is irrelevant.

With the above in mind, Applicants turn once again to the rejection of independent claim 5. In addition to the features described and argued above, claim 5 recites “a photographing unit for photographing an image of a subject, and outputting first image information that includes measurement information reflective of the actual size of the subject.” However, neither JP ‘358 nor JP ‘375, either alone or in combination, discloses or suggests a photographing unit.

On page 6 of the Office Action, in support of the rejection of claim 5, the Examiner states only that “the step of the first image information includes measurement information is obvious

because the first image can be provided by picture device or camera.”³ With that statement, the only one even remotely directed to the photographing unit recitation of claim 5, it appears to Applicants that the Examiner has overlooked the actual recitations of claim 5. Moreover, in order to make a proper *prima facie* case of obviousness, the references must disclose or suggest each and every element recited in claim 5, as was explained above. Thus, since both references are devoid of a photographing unit and do not suggest such a thing, the rejection of claim 5, and the claims that depend from it, is improper and should be withdrawn.

Furthermore, Applicants note once more the arguments made above with respect to the rejection of claim 2. To the extent that the Examiner is relying on Official Notice to make the rejection, Applicants respectfully request that the Examiner produce a reference to support the naked assertions offered in the Office Action.

Accordingly, for all the reasons set forth above, Applicants respectfully request that the rejection of claim 5, and the claims that depend from it, be withdrawn.

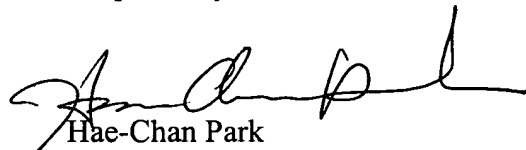
³ Applicants note that the Examiner continues to refer incorrectly to “steps.”

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, all pending claims are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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